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Filed : July 3, 2003

REMARKS

By way of summary, Claims 1-51 were originally filed. In response to a *Restriction Requirement*, Applicants elected Claims 1-19 and canceled Claims 20 through 51. Claims 1 and 2 are amended herein. Claims 52-57 have been added herein. Accordingly, Claims 1-19 and 52-57 are presented herein for further consideration by the Examiner.

New Declaration

In the *Restriction Requirement* mailed November 30, 2004, the Examiner objected to the originally filed declaration which listed an incorrect filing date for Application No. 60/441,718. Submitted herewith is a corrected declaration that lists Application No. 60/441,718 and a corresponding filing date of January 21, 2003. Applicants respectfully request that the corrected Declaration replace the originally filed declaration.

Amendments to the Specification

Applicants have amended paragraph [0001] to change the filing date of Serial No. 60/441,718 to the correct filing date to "January 21, 2003." Additionally, the Applicants have added the complete filing number of PCT/US2003/022333 for the application entitled **DIP, SPRAY, AND FLOW COATING PROCESS FOR FORMING COATED ARTICLES** filed July 3, 2003. Applicants respectfully request entry of the foregoing amendments.

Response to Judicially Created Obviousness-Type Double Patenting

The Examiner rejected Claims 1-3, 5, 12, and 14-17 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 31, 32, and 34-38 of U.S. Patent No. 6,676,883 (the '883 patent). The Examiner rejected Claims 4-7, 9-12, and 19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 31, 32, and 34-38 of the '883 patent in view of U.S. Patent No. 4,505,951 to Kennedy. The Examiner rejected Claims 6, 8, and 13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 31, 32, and 34-38 of the '883 patent in view of U.S. Patent No. 4,573,429 to Cobbs, Jr. et al. The Examiner rejected Claim 18 under the judicially created doctrine of obviousness-type double patenting as being

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unpatentable over Claims 31, 32, and 34-38 of the '883 patent in view of U.S. Patent No. 6,350,796 to Dworak et al. Applicants respectfully traverse the Examiner's rejections for the reasons set forth below.

Claims 1 and 3-19

The cited claims of the '883 patent do not disclose each and every limitation of independent Claim 1. For example, amended Claim 1 of the present application recites, among other things, applying an aqueous solution or dispersion of a second thermoplastic resin on the substantially dried first coating of the article substrate by dip, spray, or flow coating. The *Office Action* has not shown that the claims of the cited patent teach or suggest applying material to a substantially dried first coating of the article substrate by dip, spray, or flow coating. In contrast to Claim 1 of the present application, Claim 31 of the '883 patent discloses coating a polyester article having an exterior surface and an interior surface and does not recite applying material on a substantially dried first coating, as recited in Claim 1.

In the *Office Action*, the Examiner states that it is obvious to apply a plurality of coating layers. However, amended Claim 1 recites applying an aqueous solution or dispersion of a second thermoplastic resin on the *substantially dried first coating of the article substrate*. This limitation is not taught or suggested by the prior art.

Claims 32 and 34-38 of the '883 patent and the secondary references cited by the Examiner do not teach or suggest the deficiencies of Claim 31 of the '883 patent. Hence, Applicants respectfully request that the nonstatutory double patenting rejection of Claim 1 be removed.

Claims 3-19 depend from Claim 1 and further define the invention defined in Claim 1. Claims 3-19 are patentably distinguished over the cited claims and secondary references for at least the reasons set forth above with respect to Claim 1, as well as for novel and nonobvious features recited therein.

Claim 2

The cited claims of the '883 patent do not disclose each and every limitation of Claim 2. For example, amended Claim 2 of the present application recites, among other things, that curing/drying of the coating that comprises a thermoplastic epoxy resin is performed so as to form an article that *exhibits substantially no blushing or whitening when exposed to water*. The

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Office Action has not shown that Claim 31 of the '883 patent discloses the recited curing/drying of the coating of Claim 1.

Claims 32 and 34-38 of the '883 patent and the secondary references cited by the Examiner do not teach or suggest the deficiencies of the claims of U.S. Patent No. 6,676,883. Hence, Applicants respectfully request that the nonstatutory double patenting rejection of Claim 2 be removed.

Response to Rejections under 35 U.S.C. § 102 and/or § 103

The Examiner rejected Claims 1, 2, 4-12, and 14-18 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Kennedy. The Examiner rejected Claims 1-3, 5-7, and 14-17 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,472,753 to Farha in view of U.S. Patent No. 6,872,802 to Noda, further in view of U.S. Patent No. 4,731,266 to Bonnebat et al. ("Bonnebat"). The Examiner rejected Claims 4, 9-12, and 19 under 35 U.S.C. § 103(a) as unpatentable over Farha in view of Noda, further in view of Bonnebat and Kennedy. The Examiner rejected Claims 8 and 13 under 35 U.S.C. § 103(a) as unpatentable over Farha in view of Noda, further in view of Bonnebat and U.S. Patent No. 4,573,429 to Cobbs Jr. et al. The Examiner rejected Claim 18 under 35 U.S.C. § 103(a) as unpatentable over Farha in view of Noda, further in view of Bonnebat, further in view U.S. Patent No. 6,350,796 to Dworak et al. Applicants respectfully submit that the pending claims are in condition for allowance for at least the reasons detailed below.

Claims 1, 2, 4-12, and 14-18 are allowable over Kennedy

The Examiner rejected Claims 1, 2, 4-12, and 14-18 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Kennedy. The cited references, alone or in combination, do not teach or suggest each and every limitation of Claim 1. For example, Claim 1 recites, applying an aqueous solution or dispersion of a second thermoplastic resin on the substantially dried first coating of the article substrate by dip, spray, or flow coating. In contrast to Claim 1, Kennedy teaches applying a single layer of polyvinylidene chloride to a container. Hence, Claim 1 is in condition for allowance.

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The other references cited in the *Office Action* do not teach or suggest the deficiencies of Kennedy. The Examiner cites Bonnebat for a curing process. *Office Action*, paragraph 1, page 8. However, in contrast to Claim 1, Bonnebat merely teaches "suitably drying each intermediate layer" at some point in time. Col. 3, lines 50-51. Bonnebat generally discloses having several layers that undergo some drying at some point in time. Bonnebat does not disclose the specific drying/curing recited in Claim 1, namely curing until the first film is substantially dried. Thus, Kennedy and the other references cited in the *Office Action*, alone or in combination, do not teach or suggest each and every limitation of Claim 2.

Thus, the cited references, alone or in combination, do not disclose each and every limitation of Claim 1, and Applicants respectfully submit that Claim 1 is in condition for allowance.

Examiner's Combination Of Farha/Noda/Bonnebat Is Improper

In rejecting Claims 1-19, the Examiner sets forth various rejections based, at least in part, on the combination of Farha, Noda, and Bonnebat. However, the combinations of Farha, Noda, and Bonnebat in the *Office Action* are legally improper. The Examiner has not shown any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, for the asserted combination. Additionally, the Examiner improperly disregards the intended purpose of the Farha outer layers when combining the references. Each of these is discussed in detail below.

Examiner's Modification Of Farha With Noda Is Improper

One of ordinary skill would not modify the injection molding process of Farha with the teachings of Noda. It is well established that "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art *as a whole* to suggest the desirability, and thus the obviousness of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann*, 730 F.2d at 1462, 221 U.S.P.Q. at 488). "There must be evidence that 'a skilled artisan, confronted with the same problems as the inventors and with no knowledge of the claimed invention, *would select the elements* from the cited prior art references for combination in the manner claimed.'" *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1456 (Fed.

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Cir. 1998); *see also, In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

One of ordinary skill would not modify Farha with the teachings of Noda because of the differences between these references. Farha teaches forming multilayer preforms through a co-extrusion process. To form the preform, an extruded tube is placed in an injection mold and forms an outer surface of a mold cavity. Melt is then injected into a mold cavity and flows along the tube until the mold cavity is completely filled. The outer layer of Farha is formed *before* and used *during* the formation of the underlying preform. In contrast to Farha, Noda teaches roller coating, brush coating, dip coating, and spray coating to form a layer on a substrate. The layers of Noda are not used to form an underlying structure as taught by Farha. That is, Noda discloses processes used to apply material to an article *after* the article is formed. Noda, col. 18, lines 28-29. Thus, one of ordinary skill would not modify Farha with the teachings of Noda.

The *Office Action* states that one of ordinary skill would use roller coating, brush coating, dip coating, and spray coating to form the extruded layers disclosed in Farha. However, the Farha extruded layers are sufficiently thick to maintain a desired extruded profile shape during extrusion and subsequent overmolding, unlike the relatively thin layers of Noda. As shown in Figures 3 and 4 of Farha, the outer layers of the preform, which are formed by the extruded tube, are relatively thick as these layers are formed by an extrusion process. The roller coating, brush coating, dip coating, and spray coating of solutions or emulsions of Noda are not intended for forming tubes that are placed in an injection mold and then used in an overmolding process. Moreover, one of ordinary skill would not expect the Noda process for depositing only a thin layer on an article to be suitable for making an article structurally suitable for placement in a high pressure injection mold as disclosed in Farha. Thus, one of ordinary skill in the art would not use roller coating, brush coating, dip coating, and spray coating of Noda to form the extruded layers disclosed in Farha.

The *Office Action* further states that Noda teaches extrusion coating as the functional equivalent to roller coating, brush coating, dip coating, and spray coating using aqueous solutions or emulsions. *Office Action*, third full paragraph, page 7. The extrusion process of Noda is significantly different from the extrusion process of Farha. Noda discloses forming *flat laminates* by an extrusion processing using a pressure roller and a chill roller. In contrast, Farha

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discloses extruding cylindrical tubes that can be placed in an injection mold for injecting melt over the tubes. Assuming *arguendo* that the Noda considers extrusion coating and functional equivalent to roller coating, brush coating, dip coating, and spray coating using aqueous solutions or emulsions, a skilled artisan would not select the processes of Noda utilizing solutions or emulsions because of the inherent differences between an extrusion processes for forming tubes and processes utilizing solutions or emulsions for forming layers on already formed articles. The references must be considered the prior art *as a whole* to suggest the desirability of the asserted combination. Thus, the extrusion process of Noda does not provide a motivation to modify the different extrusion process of Farha with the completely different roller coating, brush coating, dip coating, and spray coating processes of Noda.

Hence, because the Examiner has not show any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, for the asserted combinations, Claims 1 and 3-9 are in condition for allowance.

Examiner's Modification Of Farha In View of Noda With Bonnebat Is Improper

The Examiner acknowledges that "Farha in view of Noda fails to teach that more than one layer of barrier coating are applied (Claim 3), each layer is substantially dried before applying next layer (Claim 1)." *Office Action*, page 7. The Examiner states that one of ordinary skill in the art would have modified Farha in view of Noda as disclosed in Bonnebat. *Office Action*, page 8. Bonnebat teaches forming thin films for application to articles, not extruded tubes for use in an injection molding as disclosed by Farha. Moreover, one of ordinary skill in the art would not use aqueous coating techniques of Bonnebat for similar reasons as discussed above with respect to Noda. The inherent differences between the Farha extruded tubes and the layers formed by aqueous solutions would lead one of ordinary skill away from the Examiner's asserted combination. Accordingly, the modification of Farha in view of Noda with Bonnebat is legally improper.

Claim 2

Amended Claim 2 recites:

A process for making a thermoplastic resin coated article, the process comprising:

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applying an aqueous solution or dispersion of a first thermoplastic epoxy resin on an outer surface of an article substrate by dip, spray, or flow coating;

withdrawing the article from the dip, spray, or flow coating at a rate so as to form a first coherent film;

curing/drying the coated article until the first film is substantially dried so as to form a first coating; and

wherein the curing/drying is performed so as to form an article that exhibits substantially no blushing or whitening when exposed to water.

The cited references, alone and in combination, fail to teach or suggest all the claim limitations of Claim 2. For example, the *Office Action* has not shown where the cited references teach or suggest curing/drying of the coating comprising a thermoplastic epoxy resin so as to form an article that exhibits substantially no blushing or whitening when exposed to water. Applicants are unable to locate any teaching or suggestion of such a curing/drying process.

As stated in paragraph [0050] of the Applicants' specification, one common problem seen in articles formed by coating using coating solutions or dispersions is "blushing" or whitening when the article is immersed in (which includes partial immersion) or exposed directly to water or high humidity (which includes at or above about 70% relative humidity). Advantageously, in some non-limiting embodiments of articles disclosed in the present application, the articles exhibit minimal or substantially no blushing or whitening when immersed in or otherwise exposed directly to water or high humidity. The articles can maintain clarity for an aesthetically appealing container.

Because the cited references do not teach or suggest each and every limitation, Applicants respectfully submit that Claim 2 is in condition for allowance.

New Claims 52-57

To claim additional embodiments, Claims 52-57 have been added. Applicants respectfully submit that new Claims 52-57 are patentable over the art of record. Accordingly, Applicants request allowance of new Claims 52-57.

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Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding *Office Action* are inapplicable to the present claims. Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on solely that portion; rather, patentability must rest on each claim taken as a whole. Applicants do not concede or acquiesce to any of the rejections in the *Office Action*. Applicants have not presented arguments concerning whether many of the applied references can be properly combined in view of the clearly missing elements noted above and the improper combination Farha, Noda, and Bonnebat. Applicants reserve the right to later contest whether a proper motivation and suggestion exists to combine the applied references. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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